

Remarks/Arguments

Claims 16-36 are currently pending in the application.

Prior to discussing the rejections of record, a brief explanation of the instant invention is considered warranted. The present invention relates to the distribution of a mailpiece within an international mailing system. In accordance with the present invention value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority but confirmation is communicated by a first postal authority to the original mailer. During the delivery process, the value-added service performed by the final handling postal authority and the data related to the delivery is captured by the final handling postal authority. The final handling postal authority then transmits this information to the first handling postal authority who then communicates the information to the original mailer. The invention is practiced such that the identity of the mailer is disclosed only to the original postal authority and not to subsequent handling postal authorities.

Claim 23 provides a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities. According to the method of claim 23, a mail item is received at a final handling post and scanned to obtain a digital image of the mail item and an identifier for an initial handling post. Also obtained is a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item. The digital images of the signature and the mail item are merged and the merged digital images are transmitted to the initial handling post. Claims 24-26 depend on claim 23. Claim 27 depends on claim 26; claim 28 depends on claim 24; claim 29 depends on claim 28.

According to claim 24, delivery confirmation is transmitted from the initial handling post to a mailer of the mail item. Claim 25 provides that the step of obtaining the digital image of the signature of the recipient includes the steps of obtaining a physical signature on a form; and scanning the physical signature to obtain the digital image of the signature. According to claim 26, the step of

transmitting the merged digital images to the initial handling post includes the steps of: retrieving an electronic address corresponding to the initial handling post; compressing the merged digital images to form a transfer file; digitally signing the transfer file; and transmitting the digitally signed transfer file to the initial handling post using the electronic address. Claim 27 provides that the electronic address is one of an e-mail address, a facsimile number and a telephone number. Claim 28 provides the step of transmitting delivery confirmation from the initial handling post to the mailer of the mail item includes the steps of retrieving an electronic address of the mailer; and sending an electronic message to the mailer confirming delivery of the mail item. Finally, claim 29 provides that the electronic address is one of an e-mail address, a facsimile number, a pager number and a telephone number.

Claim 30 provides another aspect of the present invention with a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities. According to the method of claim 30, a transfer file representing confirmation of delivery of a mail item by a final handling post is received electronically at an initial handling post. The transfer file is parsed to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item and confirmation of delivery of the mail item is sent to the mailer. Claims 31-35 depend from claim 30. Claim 32 depends from claim 30.

According to claim 31, the transfer file is digitally signed by the final handling post and the digital signature of the transfer file is verified and the transfer file is rejected if the digital signature is not correct. According to claim 32, the confirmation of delivery is sent to a mailer electronic address, which is either an e-mail address, a facsimile number, a pager number or a telephone number. According to claim 33, the step of parsing the transfer file includes parsing from the transfer file a mailer electronic address, a unique identity of the mail item and a unique identity of the mailer. According to claim 34 the step of parsing the transfer file includes parsing from the transfer file a unique identity of the mail item and a unique identity of the mailer; and the step of sending to the mailer confirmation of delivery of the mail item includes determining a mailer electronic address from a look up table. According to

claim 35, the step of sending to the mailer confirmation of delivery of the mail item includes the step of sending electronically digital images of the mail item and signature of the recipient. Finally, claim 36 provides that the digital images of the mail item and the signature of the recipient are digitally signed before being sent.

Claims 16-22 describe a system for implementing the process described in claims 23-36.

Claims 23-36 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

In paragraph 2 of the Office Action, the Examiner comments that the inventive concept in claims 23-36 only recite an abstract idea and that the recited steps do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. The Examiner cites *In re Toma (CCPA 197 USPQ 852 (1978))* in support of his position. The Examiner further states that the "recited method produces a useful, concrete and tangible result" but that the claimed invention, as a whole, is "not within the technological arts". Applicant respectfully disagrees with the Examiner's comments.

First, the Examiner incorrectly states that the present claims 23-36 only recite an abstract idea. The bolded text in the following sections identify several of the elements in the claims that are not abstract ideas. As previously stated, claim 23 provides a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities. The **mail item is received at a final handling post and scanned to obtain a digital image of the mail item and an identifier for an initial handling post. Also obtained is a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item. The digital images of the signature and the mail item are merged and the merged digital images are transmitted to the initial handling post.** In claim 25, **a physical signature is obtained on a form; and is scanned to obtain the digital image of the signature.** In claim 26, the step of transmitting the

merged digital images to the initial handling post includes the steps of: **retrieving an electronic address corresponding to the initial handling post; compressing the merged digital images to form a transfer file; digitally signing the transfer file; and transmitting the digitally signed transfer file to the initial handling post using the electronic address.** Claim 27 provides that the electronic address is one of an **e-mail address, a facsimile number and a telephone number.** Claims 30-36 include similar non-abstract ideas.

Second, the Examiner states that the recited steps do not apply, involve, use or advance the technological arts "since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. The Examiner has not supported this statement with any further comment other than to cite *In re Toma*. The bolded text in the following text identify several of the elements in the claims that cannot be performed in the mind of the user or by use of pencil and paper. One skilled in the art, and probably those not skilled in the art, would understand that a mail item received at a final handling post must use some form of scanner, such as a digital camera, when **scanning the mail item to obtain a digital image of the mail item or a digital image of a signature of the mail recipient.** Furthermore, those skilled in the art would understand that once these digital images have been obtained, that some type of processor, such as a computer, would be needed to **merge the digital images of the signature and the mail item,** and that some type of digital communications would be needed to **transmit the merged digital images to the initial handling post.** It appears to the Applicants that the Examiner believes that without specifically including a scanner or computer in the elements of claims 23-36, the claims steps can be performed in the mind of the user or by use of pencil and paper. As indicated above, this is not the case, nor is there a requirement to expressly recite in the body of the claims the technology used to implement the process. The Examiner appears to rely on *In re Toma* to require such a recitation. However, *In re Toma* neither directly or indirectly requires such a recitation. The claims at issue in *In re Toma* concern a translation process that is performed entirely

in a computer. In such a case, when the entire process is performed by a computer, it could be argued that all the steps can be performed in the mind of the user or by use of pencil and paper. However, as set forth above, this is not the case with the present invention as described in claims 23-36.

Finally, the Examiner cited *In re Toma* (CCPA 197 USPQ 852 (1978)) in support of his position that claimed invention in claims 23-36 is not within the technological arts. However, *In re Toma* actually reverses a "technological arts" rejection for claims that describe translating between natural languages in a computer.

Accordingly, the Examiner's comments simply have no merit. It is submitted that claims 23-36 clearly set forth statutory subject matter.

Claims 23-36 stand rejected under 35 U.S.C. 102(a) as being anticipated by Pintsov '036. This rejection is respectfully traversed.

The Examiner states in paragraph 4 of the Office Action that claim 23 "reads on figure 1, element 106 and 108 and also fig. 4" of Pintsov '036. Element 106 is the mailer's unique identification number. Element 108 represents service data required by the mailer and a unique identification for the mailpiece. See col. 6, lines 36-39. Figure 1 is a mailpiece having encrypted information imprinted thereon in accordance with the present invention which is thereafter utilized by a carrier in generating billing information and utilized to provide additional verifications and information and services to a mailer. Figure 4 is a block diagram of a carrier processing system for the generation of billing records. Contrary to the Examiner's comments, there is nothing in Pintsov '036 that discloses or suggests the following elements from independent claim 23:

- scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post;
- obtaining a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item;
- merging the digital images of the signature and the mail item; and

transmitting the merged digital images to the initial handling post.

Contrary to the Examiner's comments, there is nothing in Pintsov '036 that discloses or suggests the following elements from independent claim 30:

receiving electronically at an initial handling post a transfer file representing confirmation of delivery of a mail item by a final handling post;
parsing the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item; and
sending to the mailer confirmation of delivery of the mail item.

Pintsov '036 describes a system and method in which the mailpiece is scanned to obtain the mailer's identification (element 106), an encrypted hash code and addressee data. There is not teaching or suggestion of scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post.

Furthermore, the present invention provides for obtaining a digital image of a physical signature by the mail recipient. Pintsov '036, on the other hand, describes a system and method that requires digital signatures representing digitally signed messages – not obtaining digital images physical signatures of recipients See, for example, Pintsov '036 at col. 5, lines 8-13.

the mail recipient can digitally sign by encrypting a message containing unique sender identification and unique mail piece identification with his own private key. The mail sender upon receiving the confirmation can decrypt the mail receiver signature with the mail recipient public key.

Thus, Pintsov '036 does not teach or suggest the present invention as set forth in claims 23-36. In fact, the disclosure in Pintsov '036 is in no way related to the present invention as claimed, i.e., preventing subsequent postal authorities from having access to a mailer's electronic address, whereby the subsequent postal authority would be able to communicate directly with the mailer and bypass the originating postal authority in the future. Pintsov '036 does not teach or suggest anything related to multiple postal authorities, or the use of electronic mail to provide value added service confirmation.

Claim 16 stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Pintsov (US Patent No. 5,586,036) in view of USPS "3 Special Services" and PS Form 2865. It appears that claims 17-22 also stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Pintsov (US Patent No. 5,586,036) in view of USPS "3 Special Services" and PS Form 2865. However, as in the previous Office Action, this rejection is clearly stated in the statement of the rejection. For the reasons set forth above for the 103 (a) rejection of claims 23-36, this rejection is respectfully traversed.

Applicant respectfully submits that the present application is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (203) 924-3217 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



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